

REMARKS

Applicant respectfully requests reconsideration of the claims in view of the present amendments and remarks.

Basis for amendments

The amendments to claims 1 and 21 and new claims 49-94 are supported by the disclosure generally, and in particular by the original claims. The recitations of a sealed envelope and of a secure postal printer (claims 78 and 94) find particular support at, for example, the last full paragraph on page 13.

Response to rejections

The several rejections are treated in the order set forth in the Office action.

35 U.S.C. § 112, second paragraph

Claims 1-10, 15-21, 23-25, and 36-38 were rejected as indefinite for using the construction "and/or." None of the new or amended claims recites "and/or." Accordingly, the rejection is moot, and applicant requests that it be withdrawn.

35 U.S.C. § 101

Claims 1-20 and 39-47 were rejected under 35 U.S.C. § 101 as directed to nonstatutory subject matter. The rejection is respectfully traversed.

The inventions of the rejected claims are methods for requesting, generating, using, and comparing various authentication codes to test and verify the identity of parties to an electronic authorization for a financial transfer. It is evident from the disclosure as a whole and express recitations in, for example, the preamble of claim 1 that the claimed methods are implemented in the context of an array of computers which perform the specified generating, transforming, and (in some instances) communicating steps of the methods, and that the methods are dependent on the provision of information (data) by both the transferor and the transferee. Thus, the examiner errs in stating that "[t]he claimed invention does not include a series of steps to be performed by a computer." Moreover, the methods involve the communication and transformation of data as

part of a process for requesting and effecting an actual transfer of monies. Thus, it is respectfully submitted that the claims are directed to actual processes that serve useful and beneficial purposes, and not merely abstract ideas. Because performance of the claimed methods is a “practical application” of data processing algorithms that yields “a useful, concrete and tangible result,” the claims are directed to patent-eligible subject matter under § 101. Applicant accordingly requests that the examiner withdraw the rejection.

35 U.S.C. § 102(e) over Marcous ‘604

Claims 1-7, 9-11, 13, 20-31, 36-38, and 44-47 were rejected as anticipated by, and claims 8 and 12, as obvious over Marcous *et al.*, U.S. Patent No. 5,650,604. This rejection is respectfully traversed.

Marcous is directed to methods of authenticating individual transactions. As such, the methods disclosed in the reference involve generating transaction-specific security codes or PINs. These codes are generated as a function of the amount of funds transferred and an arbitrary number provided by the transferor, such as a telephone number or social security number. See ‘604 at col. 5, lines 22-33. The only database described in the reference contains information associating particular transactions with transaction-specific codes.

In contrast, the present invention is designed to facilitate a plurality of transactions involving a particular transferor or transferee. It does so by creating and associating a Personal Identifier Code (“PIC,” i.e., the “first identifier code”) with the transferor or transferee and storing that code in a database. When the code is created, it is communicated to the party it is associated with independent from transferor’s communication with the input device. Thus, when a transferor initiates a transaction, a transaction-specific security code is generated using information that is not provided to or processed at the input device. The present invention therefore provides security against interception of the first identifier code or the information used to generate it between the input device and the processing means. Additionally, the party-specific code is associated with the transferor or transferee and retained in a database, thus facilitating future transactions. The independent claims have been amended to clarify this aspect of the invention.

Unlike the claimed invention, the methods of Marcous all involve providing the numerical information used to generate a transaction-specific code at the input terminal or device. Moreover, nowhere does the reference teach means or methods for re-using all or part of the transaction-specific PIN to generate a security code for additional or subsequent transactions. Thus, Marcous does not anticipate the amended independent claims or any of the claims that depend from them. Reconsideration and withdrawal of the rejection are requested.

35 U.S.C. § 103 over Marcous '604

Claims 8 and 12 were rejected as obvious over Marcous '604. Applicant traverses this rejection.

With respect to this and the other rejections advanced under § 103, the examiner notes that the references describe particular elements of the claimed invention. The presence in the prior art of the elements of a claimed combination is not enough to establish obviousness; some motivation to combine those elements to arrive at the claimed invention must be present in the prior art. See *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The examiner has not pointed to such motivation in any of the references of record.

The differences between Marcous and the claimed invention are discussed above in connection with the rejection under § 102. Marcous does not suggest the distinguishing features of the present invention, and does it not teach that it would be desirable to modify the scheme that it describes. Because Marcous provides no reason to depart from the exclusive use of codes that are transaction-specific or to establish a permanent association between a user and an identifier code, applicant submits that none of the claims is obvious in view of the reference.

35 U.S.C. § 103 over Marcous '604 in view of Tedesco '523

Claims 15-19 were rejected as obvious over Marcous in view of Tedesco, U.S. Patent No. 6,282,523. The rejection is respectfully traversed.

The methods of Tedesco, like those of Marcous, involve event-specific codes. See '523 at the abstract. Additionally, the prior art invention is directed to solving a different problem than the present invention, namely, ensuring that funds are available to pay checks in the context of a transaction between the party presenting the checks and a bank. The examiner has identified

no teaching in the reference that would lead one of ordinary skill in the art to modify the method of Marcous to employ the distinguishing features of the invention. Accordingly, the invention of claims 15-19 is not obvious, and withdrawal of the rejection is requested.

35 U.S.C. § 103 over Marcous '604 in view of Atalla '710

Claims 14, 32, 35, and 39 were rejected as obvious over Marcous in view of Atalla, U.S. Patent No. 5,319,710. Applicant traverses the rejection.

Atalla is directed to methods of encrypting messages by generating a code combining a message-specific function and a PIN code. See '710 at the abstract. The code is generated "in response to a user's message and [PIN]." '710 at claim 1. Thus, the system and method of Atalla employ a PIN provided at the input device by the user at the time the transaction is initiated, in the conventional manner.

The present invention, as discussed above, employs a user-specific identifier code that is not entered into the input device by the user, but is instead generated anew or obtained from a separate database of users and associated identifier codes. Neither Atalla nor Marcus teaches or suggests such an arrangement, and neither teaches why it would be desirable to have a PIN not provided at the input device. Accordingly, the claims are patentable over the cited art. Withdrawal of the rejection is requested.

Other prior art made of record

Applicant has reviewed the prior art references reviewed by the examiner at pages 15-16 of the Office action. None is believed to teach the combination of features claimed in the present application. Because the examiner has not cited any of these references in a rejection, 37 C.F.R. § 1.104(c)(2), no further comment is necessary.

Conclusion

If any questions or issues remain, the examiner is invited to contact the undersigned attorney to resolve them.

Respectfully submitted,



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